

### **REMARKS**

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.116, and in light of the remarks which follow.

Entry of this amendment is proper under 37 C.F.R. § 1.116 because the Amendment places the application into condition for allowance (for the reasons discussed herein), or places the application into better form for Appeal, should an Appeal be necessary. The Amendment does not raise the issue of new matter and does not raise issues requiring additional search and/or consideration since the Amendment is directed to subject matter previously considered during prosecution. The remarks presented below supplement those presented in Applicants' earlier responses and are presented here in further response to issues raised in the final rejection. Applicants respectfully request entry of the Amendment.

Applicants thank the Examiner for acknowledging Applicants' Preliminary Amendment of December 5, 2008. Applicants also thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119 and for indicating that all certified copies of the priority documents have been received from the International Bureau.

Claims 1-15 are pending in the application.

By the above amendments, Applicants have amended the specification at page 24 to clarify the language presented therein in accordance with the Official Action's suggestion. Applicants also amended Claims 1-4, 7 and 13-15 to address the objection to Claim 4, § 112 issues and minor informalities. A claim that has been

amended in a manner that does not narrow the claim's scope should be accorded its full range of equivalents.

Turning now to the Official Action, the specification stands objected to for including an informality. For at least the reasons that follow, withdrawal of the objection is in order.

In accordance with the Official Action's suggestion, Applicants further clarified the language at page 24 of the specification.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 4 stands objected to for including an informality. For at least the reasons that follow, reconsideration and withdrawal of the objection are in order.

In accordance with the Official Action's suggestion, Applicants amended Claim 4 to add --surfactants-- after "and."

Applicants respectfully request reconsideration and withdrawal of the objection to Claim 4.

Claims 1-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. For at least the reasons that follow, withdrawal of the rejection is in order.

Concerning the rejection of Claim 1 for use of the term "Fc'," Applicants amended Claim 1 to indicate that Fc' can refer to hydroxyl crosslinking functional groups. Support for this amendment can be found at least at page 17, lines 25-27 of the specification.

Concerning the rejection of Claim 1 for use of the phrase "in particular," Applicants have deleted the phrase.

Concerning the rejection of Claim 1 for use of "halogenated reagent," Applicants have amended the claim to recite, in part, ". . . at least one reagent comprising a halogen." Support for this amendment can be found at least at paragraphs [0044] to [0056].

Concerning the rejection of Claim 1 for use of the term "compatibilizing agent," Applicants amended the claim to further explain that the compatibilizing agent is used to make the silicic particulate filler compatible with the silicone material. Support for this amendment can be found at least at paragraph [0032] of the specification.

Concerning the rejection of Claim 1 for the use of phrases "route 1" and "route II," Applicants have amended Claim 1 to further clarify the claim by indicating that the compatibilizing agent can be a first compatibilizing agent CA I for use in a first route (Route I) or a second compatibilizing agent CA II for use in a second route (Route II). Support for this amendment can be found at least at pages 16-17 of the specification.

Concerning the rejection of Claim 1 for use of the phrase "passing through dried hydrophobic silica," Applicants have deleted the phrase.

Concerning the rejection of Claim 1 for use of the phrase "a crosslinkable silicone material," Applicants have deleted "crosslinkable."

Concerning the rejection of Claim 1 for use of the phrase "low-molecular weight," Applicants have deleted the phrase.

Concerning the rejections of Claims 2-4, Applicants have similarly amended these claims to address the above-identified issues.

Concerning the rejection of Claim 2 for use of "C1," Applicants have deleted "C1" from Claim 2.

Concerning the rejection of Claim 3 for use of "C2," Applicants deleted "C2" from Claim 3.

Concerning the rejection of Claim 3 for the definition of "CA," Applicants have amended the claim to read, in part, ". . . wherein CA is different from a compatibilizing agent selected from. . ."

Concerning the rejection of Claim 7 for use of "chosen," Applicants amended the claim to read, in part, ". . . further comprising the use of: . . ."

Concerning the rejections of Claims 13, 14 and 15 for use " $SM$   $SM_1$ ," " $SM$   $SM_2$ " and " $SM$   $SM_3$ " respectively, Applicants amended Claims 13, 14, and 15 to refer to "a polyaddition silicone material ( $SM_1$ )," "a polycondensation silicone material ( $SM_2$ )," and "a polydehydrogenocondensation silicone material ( $SM_3$ )," respectively. Support for these amendments can be generally found at least at pages 16-17 of the specification.

Claims 1-14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Jackson (FR 2817262). For at least the reasons that follow, reconsideration and withdrawal of the rejection are in order.

Independent Claim 1 defines a method for preparing a suspension of a silicic particulate filler, in a silicone material ( $SM$ ) comprising:

$SM_1$  polyaddition:

at least one type A polyorganosiloxane POS carrying alkenyl crosslinking functional groups  $Fa$  capable of reacting with crosslinking functional

groups  $Fb$  (SiH) of at least one  $B$  type POS, this  $A$  POS being taken alone or as a mixture with at least one nonreactive ( $E$ ) POS;

and at least one  $B$  type POS carrying crosslinking functional groups  $Fb$  (SiH) capable of reacting with the alkenyl crosslinking functional groups  $Fa$  of the  $A$  POS(s);

and/or  $SM_2$ polycondensation:

at least one  $C$  type POS carrying hydroxyl crosslinking functional groups  $Fc$  and/or OR functional groups ( $R = C_1-C_{30}$  alkyl,  $C_2-C_{30}$  alkenyl, aryl, which are optionally substituted) precursor of functional groups  $Fc'$  (hydroxyl crosslinking functional groups), these crosslinking functional groups  $Fc$  being capable of reacting with crosslinking functional groups  $Fc$  of this  $C$  POS or of other  $C$  POSs, and with crosslinking functional groups of at least one crosslinking agent  $D$ , this  $C$  POS being taken alone or as a mixture with at least one nonreactive ( $E$ ) POS;

and/or  $SM_3$ polydehydrogenocondensation:

at least one  $C'$  type POS carrying hydroxyl crosslinking functional groups  $Fc'$  and/or OR' functional groups ( $R' = C_1-C_{30}$  alkyl,  $C_2-C_{30}$  alkenyl, aryl, which are optionally substituted) precursor of the functional groups  $Fc'$ , these crosslinking functional groups  $Fc'$  being capable of reacting with other crosslinking functional groups  $Fb'$  (SiH) of at least one  $B'$  type POS, this  $C'$  POS being taken alone or as a mixture with at least one nonreactive ( $E$ ) POS;

and at least one  $B'$  type POS carrying crosslinking functional groups  $Fb'$  (SiH) capable of reacting with the crosslinking functional groups  $Fb'$  OH or OR' of the  $C'$  POS(s);

and/or  $SM_4$ :

at least one nonreactive (*E*) POS;

this suspension being capable of being used for producing compositions which can be crosslinked by polyaddition and/or by polycondensation and/or by dehydrogenocondensation or antifoam silicone compositions;

this method being of the type in which an aqueous suspension of silicic particulate filler is made hydrophobic by treating with at least one reagent comprising a halogen, this treatment comprising a transfer of the silica made hydrophobic into a nonaqueous phase and at least one step for at least partial removal of water;

a compatibilizing agent (*CA*) to make the silicic particulate filler compatible with the silicone material (*SM*) being:

a first compatibilizing agent *CA I* for use in a first route (Route I): either selected from silazanes, taken alone or as a mixture with each other; or

a second compatibilizing agent *CA II* for use in a second route (Route II): selected from  $R^c$ -substituted halogenosilanes with  $R^c$  = hydrogeno,  $C_1$ - $C_{30}$  alkyl,  $C_2$ - $C_{30}$  alkenyl, aryl, and  $R^c$  being optionally substituted;

the said method comprising:

1.

according to route I:

1a)-- the particulate filler is selected from the group of precipitated silicas,

1b)-- the compatibilizing agent (*CA.I*) is added in one or more fractions which are identical to or different from each other, to the preparation medium,

1c)-- the mixing of all or part of the *SM*, of the filler, of water, and of the *CA* or *CAs* is optionally partly carried out in the hot state and in such a manner that the

quantity of water is such that the weight ratio  $r = (\text{water}/\text{water} + \text{silica}) \times 100$  is

defined as follows:  $40 \leq r \leq 99$ ,

Id)-- optionally at least some of the water released and of the by-products of the reaction of *CA.I* with *SM* and with the filler are drawn off,

Ie)-- the volatile species are optionally removed,

If)-- and cooled if necessary,

according to route II:

Ila)-- an aqueous silica suspension is prepared or used which comprises:

silica,

water which is optionally acidified,

at least one hydrogen bond stabilizer,

Ilb)-- optionally, part of the silicone material *SM* is incorporated into the aqueous silica suspension obtained at the end of step Ila),

Ilc)-- hydrophobic units formed by  $\equiv\text{Si}-(\text{R}^c)_{1 \text{ to } 3}$  with  $\text{R}^c = \text{hydrogeno, C}_1\text{-C}_{30}$  alkyl,  $\text{C}_2\text{-C}_{30}$  alkenyl, aryl, these groups  $\text{R}^c$  being optionally substituted, are grafted onto the silica by exposing this silica to halosilane type *CA II* acting as precursors of these units and by allowing the reaction to proceed, optionally while stirring the whole, and optionally in the hot state,

IId)-- the procedure is carried out such that the transfer of the silica grafted by hydrophobic units, from the aqueous phase to the nonaqueous phase, is carried out,

Ile)-- optionally, at least part of the aqueous phase and of the reaction by-products is drawn off,

II f)-- the medium is cooled if necessary,

II g)-- optionally, the residual acidity of the nonaqueous phase is washed off,

IIh)-- the totality or the remainder of the silicone material *SM* is mixed with the filler which is now hydrophobic,

IIi)-- the residual water is evaporated off,

IIj)-- and an oil is recovered which comprises a hydrophobic particulate filler suspension in a crosslinkable silicone material, the routes I and II leading to an oil (or slurry) comprising a suspension of hydrophobic particulate filler in a silicone material;

2. and at least one other compatibilizing agent (CA III) is used which is chosen from the group consisting of:

(i) POSSs carrying in and/or at the ends of their chains compatibilizing functional groups OR<sup>III</sup> in which R<sup>III</sup> independently corresponds to hydrogen or to a radical corresponding to the same definition as given above for R<sup>c</sup>;

(ii) siloxane resins;

(iii) silanes;

(iv) and mixtures thereof;

excluding:

di- or monofunctional (optionally less than 1 000 g/mol) siloxanes with hydroxyl ends;

amines;

and surfactants. (Emphasis added.)

Jackson relates to the preparation of a suspension of precipitated silica in a silicone oil, the suspension being usable for the production of silicones crosslinkable by polyaddition or polycondensation (RTV elastomers). (See Jackson at Abstract.)

The Official Action continues to assert that the claims in the instant application are anticipated by Jackson because Jackson discloses a method for preparing a

suspension of a silica in a silicone material usable for production of silicones (SM) crosslinkable by polyaddition and/or polycondensation where a compatibilizer (CA) such as organosilozanes, etc. can be employed. (See, Official Action at page 5.) Applicants continue to respectfully disagree.

Again, it is well-established that in order to demonstrate anticipation under 35 U.S.C. § 102, each feature of the claim at issue must be found, either expressly described or under principles of inherency in a single prior art reference. See, *Kalman v. Kimberly-Clark Corp.*, 218 U.S.P.Q. 798 (Fed. Cir. 1983). That is not the case here.

Jackson fails to disclose or fairly suggest each feature in the combination of features in the method defined in Claim 1. Specifically, the claimed process comprises preparing a suspension of particulate filler in a silicone material (SM) comprising:  $SM_1$  polyaddition and/or  $SM_2$  polycondensation and/or  $SM_3$  dehydrogenocondensation and/or  $SM_4$ ; making the particulate filler hydrophobic via treatment with at least one reagent comprising a halogen; and a first compatibility agent CA I for use in a first route (Route I) or a second compatibility agent CA II for use in a second route (Route II) leading to an oil (or slurry) comprising a suspension of hydrophobic particulate filler in a silicone material; and at least one other compatibility agent CA III.

Jackson does not disclose or fairly suggest a method for preparing a suspension of silicic particulate filler, in a silicone material comprising this combination of features including using a first compatibility agent CA I (in a specific route (Route I)) or a second compatibility agent CA II (in a specific route (Route II)) and at least one other compatibilizing agent (CA III) chosen from the specific group

of agents defined in Claim 1. (Emphasis added.)

Even if Jackson disclosed a silicone material similar in structure to the at least one other compatibility agent CA *III* claimed, it could not be said that Jackson anticipates the claimed method because Jackson does not disclose, *inter alia*,  $SM_1$  and/or  $SM_2$  and/or  $SM_3$  and/or  $SM_4$ ; treatment with at least one reagent comprising a halogen; and CA *I* or CA *II* and CA *III*.

Accordingly, Applicants submit that Jackson does not expressly or inherently describe each feature in the combination of features defined in Claim 1.

Applicants also wish to again direct the Examiner's attention to the comparative test data provided in Table 2 of the Examples at page 14, paragraph [0381]. In Table 2, the Preparation 1 is a comparative preparation made with only CAI (HMDZ) and no CAIII. Preparation 7 (an exemplary embodiment according to the claims of the instant application) is a preparation with CAI (HMDZ) and CAIII ( $\alpha,\omega$ -dihydroxylated polydimethylsiloxane oil) of very low viscosity (4-5 Si per chain). The results in Table 2 show that the addition of CAIII has a significant effect on reducing the consistency of the resulting product. (Emphasis added.) Despite the substantial increase in the silica level, the gradient values are much lower in Preparation 7 (exemplary of the instant claims) than in the comparative Preparation 1. Applicants respectfully submit that this may make it possible to consume less power during the process, which is a significant achievement. Of course, Jackson fails to recognize this.

For at least these reasons, Applicants respectfully submit that Claim 1 is patentable over Jackson. The remaining claims depend, directly or indirectly, from Claim 1 (or otherwise include substantially all of the features of Claim 1) and are

therefore also patentable over Jackson for at least the reasons that Claim 1 is patentable.

Claims 1-12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Canpont (WO 00/37549). For at least the reasons that follow, withdrawal of the rejection is in order.

Independent Claim 1 is recited above.

Canpont relates to a method for preparing a silica suspension in a silicone matrix, said suspension capable of being used for producing organopolysiloxanes crosslinkable by polycondensation. (See Canpont at Abstract).

The Official Action continues to assert that the rejected claims would have been obvious over Canpont because Canpont discloses a method for preparing a suspension of silica in a silicone material usable for production of silicones crosslinkable by polyaddition and/or polycondensation where a compatibilizer (CA) such as organosilozanes, etc. can be employed. (See, Official Action at page 5.) Applicants respectfully disagree.

Again, to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claimed features. (See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).) In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." (See *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). (See also M.P.E.P. § 2143.03.)) Applicants submit that these requirements have not been met.

In particular, Canpont, like Jackson, fails to disclose or fairly suggest each feature in the combination of features recited in independent Claim 1. For example,

Canpont does not disclose or fairly suggest a method for preparing a suspension of silicic particulate filler, in a silicone material (*SM*) comprising: *SM*<sub>1</sub> polyaddition, and/or *SM*<sub>2</sub> polycondensation and/or *SM*<sub>3</sub> polydehydrogenocondensation and/or *SM*<sub>4</sub>; treatment of the particulate filler with reagent comprising a halogen; a first compatibilizing agent (*CA I*) used in a specified first route (Route I) or a second compatibilizing agent (*CA II*) used in a specified second route (Route II) and at least one other compatibilizing agent (*CA III*). Thus, the rejection over Canpont also does not reflect a proper consideration of "all words" in Claim 1 (e.g., the Official Action does not give proper consideration to "*SM*<sub>1</sub> polyaddition," "*SM*<sub>2</sub> polycondensation," "*SM*<sub>3</sub> polydehydrogenocondensation," "*SM*<sub>4</sub>," "reagent comprising a halogen," "*CA I*," "*CA II*," and "at least one other compatibilizing agent (*CA III*)") in judging the patentability of Claim 1 and its dependent claims over Canpont.

Further, Applicants again submit that the comparative results in Table 2 of the Examples at page 14, paragraph [0381] concerning the properties achieved by using the at least one other compatibilizing agent *CAIII* in the claimed process, are secondary considerations that must be considered. Indeed, the Federal Circuit has determined that evidence of secondary considerations can be the most probative and cogent evidence in the record. It can establish that an invention appearing to have been obvious in view of the prior art was not. (See, *Stratoflex Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871, 879 (Fed. Cir. 1983); and *Joy Technologies v. Manbeck*, 17 U.S.P.Q.2d 1257 (D.D.C. 1990).) In the instant Official Action, there is no appreciation in Canpont, alone or in combination with any other evidence identified in the Official Action, of the surprising results obtained by the claimed combination of features. Accordingly, even if the Official Action had established a *prima facie*

showing of obviousness, which Applicants continue to submit that it has not, the unexpected results achieved by the claimed combination of features (including CA I or CA II and CA III) would rebut such a showing.

For at least these reasons, Claim 1 is patentable over Canpont. The remaining claims depend, directly or indirectly, from Claim 1 (or otherwise include substantially all of the features of Claim 1) and are, therefore, also patentable over Canpont for at least the reasons that Claim 1 is patentable. Reconsideration and withdrawal of the rejection are respectfully requested.

From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By:

A handwritten signature in black ink, appearing to read "Martin A. Bruehs", is written over a horizontal line.

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